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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,397	04/20/2000	Richard R. Reisman	RRR-00-001US	4230

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MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102-3833

EXAMINER

NGUYEN, TANH Q

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/553,397	Applicant(s) REISMAN, RICHARD R.	
	Examiner Tanh Q. Nguyen	Art Unit 2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-26 and 28-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-26 and 28-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/30/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 5, 2005 has been entered.

Information Disclosure Statement

2. The information disclosure statement filed September 30, 2005 fails to comply with the provisions of 37 CFR 1.52(e) and 37CFR 1.98.

At least some of the information on the CD-ROM/DVD does not fall into any of the categories listed in 37 CFR 1.52(e)(1)

The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:

- (i) A computer program listing (see § 1.96);
- (ii) A "Sequence Listing" (submitted under § 1.821(c)); or
- (iii) Any individual table (see § 1.58) if the table is more than 50 pages in length, or if the total number of pages of all of the tables in an application exceeds 100 pages in length, where a table page is a page printed on paper in conformance with paragraph (b) of this section and § 1.58(c).

Many of the data files are not in ASCII format as required by 37 CFR 1.52(e)(3)(i)

Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard

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Code for Information Interchange (ASCII). CD-R discs must be finalized so that they are closed to further writing to the CD-R.

Further, the conversion of a paper document to an ASCII data format for an IDS will not usually provide an accurate and complete version. Thus the requirement for a copy of the listed document is not complied with 37 CFR 1.98(a)(2) by the CD-ROM/DVD.

The CD-ROM/DVD will not be made part of the permanent record, and the information referred to therein has not been considered as to the merits.

Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 20-21, 32; 25, 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant cited page 39, lines 4-7

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as support for the amendment. The citation however appears to only support amendments to claims 16, 28. The examiner has reviewed the section labeled "Receipt of broadcast data" (page 38, line 22-page 39, line 8) and does not find support for the following limitations:

"selecting the first one of the plurality of independently operated data sources from a listing of each of the plurality of independently operated data sources" - as recited in claims 20-21, 32;

"wherein the method is performed a plurality of consecutive times, wherein during each time the method is performed, a user at the user station can access desired data objects that have previously been captured and stored during a prior time the method is performed" - as recited in claim 25; and

"wherein the user station enables a user to access the at least one captured and stored desired data object while the user station receives, captures, and stores additional desired data objects" - as recited in claim 36.

Applicant is required to either remove the new matter, or specifically point out in the disclosure the support for the above limitations - in the reply to this Office Action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 16-21, 23-26, 28-32, 34-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Joseph et al. (US 5,819,034).

7. As per claims 16-21, 23-26, Joseph teaches a method for operating a user station [20, FIG. 1], comprising:

receiving information to cause the user station to watch for at least one desired data object in a broadcast data stream [col. 12, lines 56-65], the broadcast data stream including the at least one desired data object and at least one other data object [col. 4, lines 33-39], and the at least one desired data object being identified in the broadcast data stream by an object identifier (packet identification information) contained in the broadcast data stream [col. 4, lines 33-39];

receiving the broadcast data stream [via high speed data link 30, FIG. 1], and

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capturing and storing the at least one desired data object from the received broadcast data stream based on said information and the at least one desired data object's object identifier contained in the broadcast data stream [col. 4, line 66-col. 5, line 9].

Joseph further teaches the at least one desired data object being stored in temporary storage at the user station, fetching the at least one desired data object from the temporary storage, preparing the fetched at least one desired data object for use at the user station [col. 5, lines 5-9];

the at least one desired data object being supplied by a first one of a plurality of independently operated data sources [channel sources 108, 108A - FIG. 2; col. 9, lines 43-51] and selecting the first one of the plurality of independently operated data sources from a listing of each of the plurality of independently operated data sources [col. 12, line 66-col. 13, line 2; col. 4, lines 54-56]; an application programming interface enabling a software application to select the first one of the plurality of independently operated data sources [col. 12, lines 56-65];

tuning the user station to receive the broadcast data stream [col. 4, lines 54-56];

the at least one desired data object comprising data to which a user at the user station is entitled [entitlement with a cable system [col. 2, line 26; col. 7, line 9]];

the method being performed a plurality of consecutive times, wherein during each time the method is performed, a user at the user station can access desired data objects that have previously been captured and stored during a prior time the method is performed [col. 5, lines 32-44];

a user at the user station selecting the at least one desired data object to be captured and stored [col. 12, lines 56-65].

8. As per claims 28-32, 34-35, 37, the claims generally correspond to claims 16-20, 23-26 and are rejected on the same bases.

9. As per claim 36, Joseph teaches the user station enabling a user to access the at least one captured and stored desired data object while the user station receives, captures, and stores additional desired data objects [col. 5, lines 32-44].

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 22, 33 rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph et al, and in the alternative over Joseph et al. in view of Wagner et al. (US 5,761,602).

12. Joseph does not teach the broadcast data stream being broadcast by Internet multicasting. Since applicant discloses the broadcast information distribution system being an alternative to modem-based wireline or wireless calling to a server; and on the Internet, such broadcasting to a selected group of recipients is called multicasting (page 38, lines 22-27), the use of a broadcast information distribution system or Internet multicasting is not significant, and it would have been obvious to one of ordinary skill in

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the art at the time the invention was made to use Internet multicasting in order to practice the Joseph's invention in an Internet environment.

13. Wagner teaches information from the Internet being multicast to subscribers via a router/distributor [FIG. 1] in order to constantly receive the information without incurring telephone connection costs [col. 5, lines 65-67]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Wagner's teachings into Joseph, in order to avoid incurring telephone connection costs.

Response to Arguments

14. Applicant's arguments with respect to claims 16-26, 28-37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanh Quang Nguyen whose telephone number is (571) 272-4154 and whose e-mail address is tanh.nguyen36@uspto.gov. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh, can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for After Final, Official, and Customer Services, or (571) 273-4154 for Draft to the Examiner (please label "PROPOSED" or "DRAFT").

Effective May 1, 2003 are new mailing address is:


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Effective December 1, 2003, hand-carried patent application related incoming correspondences will be to a centralized location.

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04/17/2006

TQN
April 17, 2006